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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,126	04/20/2001	David Trost	005524 USA/PDC/WF/DB	8689

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APPLIED MATERIALS, INC.
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SANTA CLARA, CA 95050

EXAMINER

LATTIN, CHRISTOPHER W

ART UNIT PAPER NUMBER

2812

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,126

Applicant(s)

TROST ET AL.

Examiner

Christopher W Lattin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 and 23-30 are rejected under 35 U.S.C. 102(b) based upon the offer for sale of the invention. Exhibit A evidences a sale on June 24, 1999. The quote did not detail the claimed method nor any manner in which Etec would control such a method, and merely required that process results of the electron beam lithography machine as a whole be reported. Such an offer for sale does not qualify as experimental use and the MEBES system is therefore barred as on sale more than one year prior to filing in the U.S.

Claims 1-6 10, 12, 23, 25, 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Morad et al. (U.S. Patent 6,276,072).

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The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Morad et al. teach a method of manipulating a work piece near a heating source, moving the work piece away from the source and evacuating the chamber.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9, 11, 13, 14, 24, 26, 27, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morad et al. (U.S. Patent 6,276,072).

Morad et al. teach a method of manipulating a reticle within an evacuated chamber of an electron beam lithography apparatus, but fails to teach the exact processing conditions presently claimed. Official Notice is taken that although the particular temperature and pressure ranges are not specifically mentioned in the applied reference, such parameters would have been obvious. "Under some circumstances [process ranges] may impart patentability to a process if the particular ranges claimed

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produce a new and unexpected result which is different in kind and not merely degree from the results of the prior art... such ranges are termed "critical ranges and the applicant has the burden of proving such criticality... More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller* 105 USPQ 233, 255 (CCPA 1955). See also *In re Waite* 77 USPQ 586 (CCPA 1948); *In re Scherl* 70 USPQ 204 (CCPA 1946); *In re Irmischer* 66 USPQ 314 (CCPA 1945); *In re Norman* 66 USPQ 308 (CCPA 1945); *In re Swenson* 56 USPQ 372 (CCPA 1942); *In re Sola* 25 USPQ 433 (CCPA 1935); *In re Dreyfus* 24 USPQ 52 (CCPA 1934). Furthermore, official notice is taken that though Morad et al. only teach that the invention can be included as one of multiple process chambers of a fabrication system, it would have been obvious to include a lithography write chamber.

Response to Arguments

Applicant's arguments filed 6/2/03 have been fully considered but they are not persuasive.

Applicant argues that purchaser's monitoring of the results of using the apparatus evidences experimental use. Initially it is noted that there is no evidence currently on the record that the seller in fact monitored any results. Secondly, applicant has not shown that experimentation was the focus of the use. "Experimentation must be the primary purpose and any commercial exploitation must be incidental." MPEP 2133.03(e).

MPEP 2133.03(e)(1) [R-1] entitled, Commercial Exploitation, indicates that "One policy of the on sale and public use bars is the prevention of inventors from exploiting their inventions commercially more than 1 year prior to the filing of a patent application. Therefore, if applicant's precritical date activity is a sale or offer for sale that is an attempt at market penetration, a patent is barred. Thus, even if there is bona fide experimental activity, an inventor may not commercially exploit an invention more than 1 year prior to the filing date of an application. In re Theis, 610 F.2d 786, 793, 204 USPQ 188, 194 (CCPA 1979). As the degree of commercial exploitation surrounding 35 U.S.C. 102(b) activity increases, the burden on an applicant to establish clear and convincing evidence of experimental activity with respect to a public use becomes more difficult. Where the examiner has found a prima facie case of a sale or an offer to sell, this burden will rarely be met unless clear and convincing necessity for the experimentation is established by the applicant. This does not mean, of course, that there are no circumstances which would permit alleged experimental activity in an atmosphere of commercial exploitation. In certain circumstances, even a sale may be necessary to legitimately advance the experimental development of an invention if the primary purpose of the sale is experimental. In re Theis, 610 F.2d 786, 793, 204 USPQ 188, 194 (CCPA 1979); Robbins Co. v. Lawrence Mfg. Co., 482 F.2d 426, 433, 178 USPQ 577, 582 (9th Cir. 1973). However, careful scrutiny by the examiner of the objective factual circumstances surrounding such a sale is essential. See Ushakoff v. United States, 327 F.2d 669, 140 USPQ 341 (Ct.Cl. 1964); Cloud v. Standard Packaging Corp., 376 F.2d 384, 153 USPQ 317 (7th Cir. 1967). Applicant has so far failed to present clear and

convincing evidence that the measurements described on page 14 of the TEST PROCEDURE (cited by applicant) in the submitted documents satisfies the requirement for a necessity for the experimentation. In fact, it is unclear how the indication of measuring of the uniformity and accuracy of certain parameters is evidence at all of experimentation of the presently claimed process. There is no listing of how to conduct the measurements, who is to conduct them or how the inventor is maintains control over the testing.

In support of the experimental use argument applicant notes that the apparatus could be returned if it failed to meet certain desired specifications. Such a return policy is customary when products are sold and is often set out in a warranty or guarantee clause. However, such an agreement is not evidence that the product fell under the experimental use exception to the on-sale bar.

MPEP 133.03(e)(4) sets forth factors indicative of an experimental purpose as follows:

- (1) the necessity for public testing,
- (2) the amount of control over the experiment retained by the inventor,
- (3) the nature of the invention,
- (4) the length of the test period,
- (5) whether payment was made,
- (6) whether there was a secrecy obligation,
- (7) whether records of the experiment were kept,

- (8) who conducted the experiment,
- (9) the degree of commercial exploitation during testing,
- (10) whether the invention reasonably requires evaluation under actual conditions of use,
- (11) whether testing was systematically performed,
- (12) whether the inventor continually monitored the invention during testing, and
- (13) the nature of contacts made with potential customers.

See Allen Eng'g Corp. v. Bartell Indus., Inc., 299 F.3d 1336, 1353, 63 USPQ2d 1769, 1780 (Fed. Cir. 2002) quoting EZ Dock v. Schafer Sys., Inc., 276 F.3d 1347, 1357, 61 USPQ2d 1289, 1296 (Fed. Cir. 2002) (Linn, J., concurring). There is no evidence currently on the record that any of these factors weigh in applicant's favor. For example, there is no evidence of a secrecy agreement, that public testing was required or that the testing referred to in the documents was ever performed. The rejection under 102(b) is maintained and made final.

Applicant's arguments with reference to the rejection under 35 USC § 103 are moot in view of the new grounds of rejection necessitated by the amendment. The examiner notes that the original claims indicated moving the work piece closer to the heat source enhanced thermal management and is now claiming the same benefit by removing the work piece from the heat source. The prosecution history therefore makes unclear what applicant regards as the invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

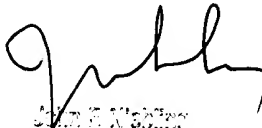
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Lattin whose telephone number is (703) 305-3017. The examiner can normally be reached Monday through Friday from 8:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Niebling, can be reached at (703) 308-3325. The fax numbers for this Group are (703) 872-9318 for responses to non-final actions and (703) 872-9319 responses to final actions.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

CWL 
June 27, 2003


John P. A. Smith
Supervisory Patent Examiner
Washington, D.C. 20590